Appenl No. 2004-0921

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In re Application of: GIROUARD et al.

Application No.: 09/472 134

Filed: December 23, 1999

Title: SNOWMOBILE

Confirmation No.: 8367 Group Art Unit: 3611

Examiner: Anne Marie Boehler

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE APPEALS & INTERFERENCES

In re PATENT APPLICATION OF

GIROUARD et al.

Appln. No.: 09/472,134

Filed: December 23, 1999

Title: SNOWMOBILE

Group Art Unit: 3611

MAY 28 2004

Examiner: Anne Marie Boehler

Confirmation No.: 8367

May 28, 2004

MOTION FOR INTRODUCTION OF DEMONSTRATIVE EVIDENCE

Via Facsimile: (703) 308-7952
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants respectfully request permission to present two snowmobiles, one constructed according to the instant application and one constructed according to the prior art, at the oral hearing scheduled for June 10, 2004.

During a March 31, 2004 teleconference between Craig Feinberg of the U.S. Patent and Trademark Office and Appellants' representative John Darling, Appellants requested permission to present the two snowmobiles for inspection by the Board during the oral hearing. Mr. Feinberg referred Appellants' request to Mr. Dale Shaw.

During an April 7, 2004 teleconference between Mr. Shaw and Mr. Darling, Mr. Shaw denied Appellants' request, citing safety, traffic, and other logistical concerns. Mr. Shaw indicated that reconsideration of the decision could be sought in writing. By this motion, Appellants respectfully request such reconsideration.

As stated on page 1 of the Appeal Brief filed May 27, 2003, this application is the parent of U.S. Application 09/877,188. As also indicated on page 1 of the Appeal Brief, Appellants intended to request that the oral hearings for the instant application and U.S. Application 09/877,188 be conducted consecutively, with the introduction of exhibits during each oral hearing. Subsequent events in the prosecution of U.S. Application 09/877,188 will not permit consideration of the instant appeal and the appeal in U.S. Application 09/877,188

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to be considered consecutively. However, Appellants respectfully submit that these subsequent events make introduction of exhibits, including a snowmobile constructed according to the instant application, highly relevant to a complete consideration of the instant appeal.

An Appeal Brief was filed May 28, 2003 in U.S. Application 09/877,188. In response to the May 28, 2003 Appeal Brief, prosecution was reopened by Examiner Luby of U.S. Application 09/877,188. In an attempt to reach a resolution of the issues in U.S. Application 09/877,188, a personal interview was conducted on September 10, 2003. Present at the interview were the undersigned, Caroline Dennison and John Darling of Pillsbury Winthrop LLP, Jonathan Cutler of Bombardier Recreational Products Inc., the assignee of the instant application, and Bruno Girouard, the first listed inventor. Also present were Examiner Luby, Quality Assurance Specialist (QAS) Terry Melius of Technology Center 3600, Supervisory Patent Examiner (SPE) Dickson of Art Unit 3616, and Examiner Boehler.

At the September 10, 2003 interview, an inventive snowmobile and a prior art snowmobile were presented for review by Examiners Luby and Boehler, SPE Dickson and QAS Melius. Mr. Girouard explained the history of the design of the inventive snowmobile and demonstrated the positioning of a rider on both the inventive snowmobile and the prior art snowmobile. Examiners Luby and Boehler, SPE Dickson and QAS Melius were permitted to ask questions regarding the differences between the inventive snowmobile and the prior art snowmobile. It is the recollection of the undersigned that each participant from the PTO did ask questions of Mr. Girouard and Appellants' representatives.

The instant appeal includes the issue of whether: 1) the specification contains a written description of the invention sufficient to demonstrate that Appellants had possession of the claimed invention as of the filing date; 2) the specification enables one of ordinary skill in the art to make and use the claimed invention; and 3) whether the claims particularly point out and distinctly claim the subject matter which Appellants regard as their invention. In order to fully assess these issues, an examination of a snowmobile constructed according to the specification and claims of the instant application is necessary to demonstrate that Appellants' specification fully complies with the enablement and written description requirements of 35 U.S.C. § 112, 1st paragraph and that the claims fully comply with 35 U.S.C. § 112, 2nd paragraph.

Appellants respectfully submit that the operability of the claimed embodiments including both the steering device and the windshield can be clearly demonstrated by an

examination of a snowmobile constructed according to the instant application. As discussed in detail in the July 9, 2002 § 132 Declaration, Robert Handfield concluded that one of ordinary skill in the art would have readily recognized that a vehicle would operate as disclosed without undue experimentation. A snowmobile constructed according to the instant application is the best evidence in support of such a conclusion.

A snowmobile constructed according the instant application will also clearly demonstrate that Appellants were in possession of the claimed invention, including the runnel and the toe-holds, as of the filing date. As discussed in detail throughout prosecution, the term "tunnel" is a term of art clearly recognized and understood by those of ordinary skill in the art of snowmobiles and is not new matter. In addition, a snowmobile constructed according to the instant application will clearly demonstrate the relationship of the tunnel to other structures of the snowmobile and that Appellants were in possession of the invention as of the filing date. The toe-holds, and their position and relationship with respect to the feet of a rider, are clearly described and shown in the application as originally filed as examination of a snowmobile constructed according to the application will clearly demonstrate.

Appellants also respectfully submit that the definiteness of the terms "standard rider" and "standard position" can be most accurately determined by an examination of a snowmobile constructed according to the instant application. The recited relationships of the standard rider and the standard position to the various claimed features of the snowmobile are most fully appreciated by examining a snowmobile constructed according to the instant application. It is respectfully submitted that such an appreciation can not be fully appreciated by examination of other evidence, for example scale models.

Finally, Appellants respectfully submit that a complete and accurate consideration of the instant appeal should include all evidence considered by Examiner Boehler during prosecution. As discussed above, Examiner Boehler was present at the September 10, 2003 interview during which the inventive snowmobile and prior art snowmobile were demonstrated. As the Examiner's Answer was mailed September 10, 2003, the same day as the interview, it appears that Examiner Bøehler completed the Examiner's Answer prior to the interview and the demonstration of the snowmobiles. However, Appellants clearly referenced the September 10, 2003 interview and demonstration in the October 22, 2003 Reply Brief. Accordingly, it is respectfully submitted that Examiner Boehler had the opportunity to reconsider the instant appeal in light of the September 10, 2003 interview and demonstration.

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Permission to introduce a snowmobile constructed according to the instant application and a snowmobile constructed according to the prior art as demonstrative evidence at the June 10, 2004 oral hearing are respectfully requested.

Respectfully submitted,

Pillsbury Winthrop LLP

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